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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,793

09/10/2008

Kazuhiro Suga

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EXAMINER

ADKINS, CHINESSA T

ART UNIT

PAPER NUMBER

4131

MAIL DATE

DELIVERY MODE

05/06/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,793	Applicant(s) SUGA ET AL.	
	Examiner CHINESSA ADKINS	Art Unit 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/29/2006, 9/8/2008, 1/12/2009</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mori et al. (U.S. Patent No. 6,326,086).

4. Regarding claims 1-3 and 7, Mori et al. teaches a laminate decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-10) which comprises a base film and a decorative layer provided on the base film (col. 2, lines 1-4). The decorative sheet has an elongation at break as measured at 120 °C of 200 to 400% (col. 8, lines 34-44). Mori et al. is silent on the elongation at break as measured at 25 °C of 3 to 10%. It is elementary that a mere recitation of a newly discovered property, inherently possessed by the things in the prior art, does not cause a claim

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drawn to those things to distinguish over the prior art (In re Swinehart et al, 169 USPQ 226 at 229). It is therefore inherent that the inclusion of the same resin composition in Mori et al. would possess the same elongation at break as measured at 25 °C as the instant application because it possesses all the other claimed properties in the same structure.

5. In the alternative, one of ordinary skill in the art would deem the elongation at break as measured at 25 °C of 3 to 10% of an acrylic resin an obvious property of the resulting material. Mori et al. teaches a laminate decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-10) which comprises a base film and a decorative layer provided on the base film (col. 2, lines 1-4). The resulting decorative sheet has an elongation at break as measured at 120 °C of 200 to 400% (col. 8, lines 34-44). Additionally, Mori et al. teaches 110 °C is the lower value of the temperature range of 110 °C to 130 °C which is suitable for three-dimensionally preforming a film having a low softening point such as acryls (col. 7, lines 8-17, col. 8, lines 13-17). It is therefore obvious that the elongation at break as measured at 25 °C of 3 to 10% is an understood property to one of ordinary skill in the art because it possesses all the other claimed properties in the same structure.

6. Regarding claims 4-5 and 8-9, Mori et al. teaches a decorative sheet wherein the base film is formed of an acrylic resin composition containing polymethacrylate or a derivative thereof as a primary component (col. 8, lines 46-49).

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7. Regarding claims 6 and 10, Mori et al. teaches a decorated resin molded product comprising a resin molding and a decorated sheet wherein the decorative layer of the decorative sheet is bonded to the molding (col. 2, lines 1-5).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHINESSA ADKINS whose telephone number is (571)270-5543. The examiner can normally be reached on Monday - Friday; 8:00 - 4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Seidleck/

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Supervisory Patent Examiner, Art Unit 1765

/C. A./

Chinessa Adkins

Examiner, Art Unit 4131

5/4/2011